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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	W. David Conley	)	
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Serial No.:	09/475,531	)	Group Art Unit: 2643
		)	
Filed:	December 30, 1999	)	Examiner:
		)	Tran, Quoc Duc
		)	
For:	METHOD AND SYSTEM FOR	)	
	CHARGING A SET ACTIVATION	)	
	FEE FOR PAY TELEPHONE	)	
	USAGE	)	

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Sheila Smedick

NAME

*Sheila Smedick*  
signature

6/15/06  
date

Mail Stop AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

REQUEST FOR PRE-APPEAL BRIEF CONFERENCE

In response to the Final Office Action mailed March 15, 2006, and in conjunction with the concurrently filed Notice of Appeal, Applicants request a pre-Appeal conference in view of the following remarks.

### REMARKS

In response to the Office Action dated March 15, 2006, Applicant respectfully requests reconsideration based on the following remarks. Applicant respectfully submits that the claims as presented are in condition for allowance.

Claims 1, 3-7, 26 and 27 were rejected under 35 U.S.C. § 103 as being unpatentable over Nolting in view of Lesley and Casner. This rejection is traversed for the following reasons.

According to exemplary embodiments, a call is established and a set activation fee is charged only after the billing information has been confirmed. This set activation fee helps defray the cost of providing service to a PSTN to remote locations. For example, claim 1 recites "providing a dial tone to the set activation fee telephone from the public switched telephone network if the billing information is valid." In exemplary embodiments, no dial tone is provided until the billing information is confirmed. In fact, a false dial tone may be generated (Applicant's specification, page 3, lines 7-10) which is then released and replaced with a dial tone once the billing information is approved (Applicant's specification, page 3, lines 7-10).

Nolting allows the calls to be placed from a set activation fee phone and then attempts to track or identify such calls based on statistics. Column 30, lines 10-39 describes analyzing volume and duration of calls to detect calls to calling card numbers and then charging the set activation fee based on such calls. Thus, Nolting does not validate billing information, as acknowledged by the Examiner.

The Examiner relies on Lesley for determining if billing information is valid prior to placing a telephone call. The Examiner notes that Nolting and Lesley do not teach seizing a true dial tone once billing information is valid and relies on Casner for this feature. Applicant asserts that the proposed combination Casner, Lesley and Nolting would not be operative and thus, the proposed combination is not proper under 35 U.S.C. § 103.

In applying Nolting, the Examiner relies on column 30, lines 10-39, which relates to phone calls made from pay phones. The system of Lesley places a call from a set activation fee pay telephone in order to confirm that the user has account with sufficient funds to place a call. Alternate embodiments allow a user's home or business device to be pre-designated

as a prepay phone, but a pay phone would not be pre-designated as it is not associated with any one user. Thus, the combination of Lesley and Nolting does not make sense as Lesley requires a user to designate a phone associated with a user, but Nolting is directed to public pay phones which cannot be associated with any one user.

Further, Lesley needs an actual dial tone in order for the user to dial a prepay network service telephone number. Therefore, the false dial tone of Casner would not be effective in Lesley as an actual call is needed to confirm prepaid billing information for a set activation fee pay phone in Lesley.

For the above reasons, the proposed modification to Lesley would render Lesley unsatisfactory for its intended purpose. As noted in MPEP § 2143.01, if proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). Thus, the Examiner has failed to raise a *prima facie* case of obviousness.

Furthermore, the system of Casner is related to capturing billing information for calls placed from a PBX. Neither Nolting nor Lesley mention PBX and it is not clear why one of ordinary skill would combine features from a PBX billing system (i.e., Casner) into systems for managing payment of PSTN calls. Casner generates a PBX dial tone until user station identifier is entered so the call can be tracked to a user's station. Such a feature would limit Nolting and Lesley to PBX applications which is clearly not the intent of Nolting and Lesley. Thus, it would not have been obvious to combine Casner with Nolting and Lesley as proposed by the Examiner.

For at least the above reasons, claim 1 is patentable over Nolting in view of Lesley and Casner. Claims 3-7, 26 and 27 depend from claim 1 and are patentable over Nolting in view of Lesley and Casner for at least the reasons advanced with reference to claim 1.

Furthermore, claim 26 recites "determining whether the billing information is valid includes determining if an account is active, without determining the funds available." This is clearly distinct from pre-pay systems such as Lesley and is contrary to the operation of Lesley. Lesley states that funds need to be available to complete a call in column 2, lines 20-23. It is well settled that if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings

of the references are not sufficient to render the claims *prima facie* obvious. See MPEP § 2143.01. The proposed modification to Lesley would change this principle of operation. Thus, claim 26 is not obvious over Nolting in view of Lesley and Casner.

Claims 23 and 24 were rejected under 35 U.S.C. § 103 as being unpatentable over Nolting in view of Casner. Claim 23 recites "prior to placing the telephone call to the called telephone number, determining whether billing information for the telephone call is valid." Nolting fails to teach determining whether payment information is valid prior to placing the call. Nolting allows the calls to be placed from a set activation fee phone and then attempts to track or identify such calls based on statistics. Column 30, lines 10-39 describes analyzing volume and duration of calls to detect calls to calling card numbers and then charging the set activation fee based on such calls. Thus, Nolting does not validate billing information, as acknowledged by the Examiner.

The system of Casner is related to capturing billing information for calls placed from a PBX. Nolting does not reference PBX and specifically references PSTN calls from pay phones. Casner generates a PBX dial tone until a user station identifier is entered so the call can be tracked to a user's station. Such a feature would limit Nolting to PBX applications which is clearly not the intent of Nolting.

Further, there is no suggestion in Nolting to validate billing information prior to placing a call. Nolting approaches the problem by tracking calls and determining statistically whether calls are associated with a set activation fee pay phone. There is no teaching or suggestion in the references to combine Nolting and Casner as proposed by the Examiner. Thus, it would not have been obvious to combine Casner with Nolting and Lesley as proposed by the Examiner.

For the above reasons claim 23 is patentable over Nolting in view of Casner. Claim 24 depends from claim 23 and is patentable over Nolting in view of Casner for at least the reasons advanced with reference to claim 23.

In view of the foregoing remarks, Applicant submits that the above-identified application is now in condition for allowance. Early notification to this effect is respectfully requested.

If there are any charges with respect to this response or otherwise, please charge them to Deposit Account 06-1130 maintained by Applicant's attorneys.

Respectfully submitted,

By: 

David A. Fox  
Registration No. 38,807  
CANTOR COLBURN LLP  
55 Griffin Road South  
Bloomfield, CT 06002  
Telephone (860) 286-2929  
Facsimile (860) 286-0115  
Customer No. 36192

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